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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,191

12/31/2003

Jenn-Tsang Hwang

HWAN3031/REF

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EXAMINER

HEARD, THOMAS SWEENEY

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,191

Applicant(s)

HWANG ET AL.

Examiner

Thomas S Heard

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-10 and 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Objections

The claims are objected to for the following informalities:

Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p). Claim 1 contains a number of chemical moieties that need to be clearly separated for ease of definition and delineation. By example in the instant application:

A compound of a formula (I):

wherein A is ...,

wherein Ar is a substituted or an unsubstituted phenyl group,

m is an integer between 0 to 4,

Het is a substituted or an unsubstituted 4 to 8 member heterocyclic group,

n is an integer between 0 to 4 ... etc.

Definitions of the functional groups should be superscripted and not subscripted. Thus the R groups of claim 1 and throughout the application should read R¹, R², R³, R⁴, and R⁶.

Structures as drawn are not defined as to whether their termini are points of connection (the line being a bond) or an atom, such as CH₂ or an implied CH₃.

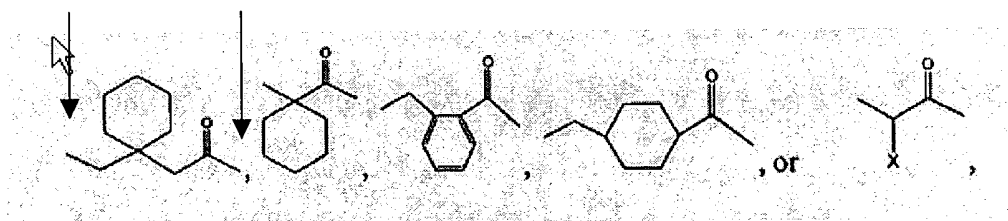
Claims 11 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 11 recites a composition comprising the compound of claim 1 but no additional ingredients are recited.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Some of the functional groups drawn in claim one (1) are ambiguous in the manner in which they bind their intended atoms. Examples from claim one (1) are given below:

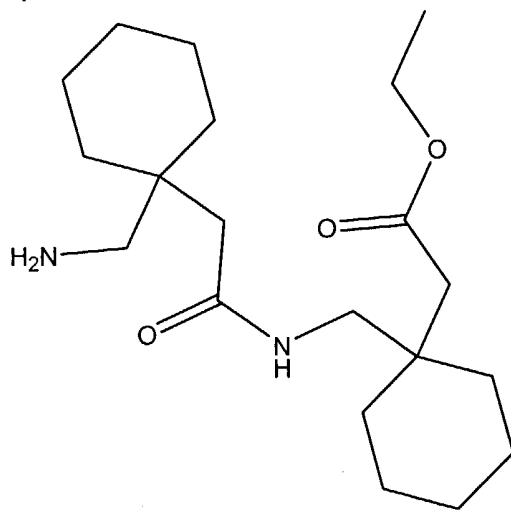


Given the open interpretation of the termini of each of the groups, as indicated in the drawn arrows in one example, there are two ways in which R^2 may bind $-N(R^3R^4)$ as defined in A and needs clarification. For this office action the termini are taken to be bonds as interpreted from the structure of the elected species.

Election/Restrictions

Applicant's election without traverse of the species of embodiment 2, on page 11 of the specifications, IUPAC chemical name (1-{{2-(1-Aminomethyl-cyclohexyl)-acetyl-amino}-methyl}-cyclohexyl)-acetic acid ethyl ester, in the reply filed on December 3, 2004 is acknowledged.

The elected compound



(1-{[2-(1-Aminomethyl-cyclohexyl)-acetyl-amino]-methyl}-cyclohexyl)-acetic acid ethyl ester

Has been found to be free of the art. A subsequent search did result in prior art being found from the compounds claimed in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryans et al (U.S. Patent 2003/0216469 A1). Bryans discloses the compound {1-(phenylacetyl-amino-methyl)-cyclohexyl}-acetic acid found on page 10 and Example 9.

Claims 2-10 are withdrawn from consideration as the generic claim is not allowable.

Conclusion

The elected species is free of the art and allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas S Heard whose telephone number is (571) 272-2064. The examiner can normally be reached on 9:00 a.m. to 6:30 p.m..

Art Unit: 1654

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TSH

A handwritten signature in black ink, appearing to read "Bruce Campell". The signature is fluid and cursive, with the first name "Bruce" and last name "Campell" clearly distinguishable.

**BRUCE R. CAMPPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**